

### **REMARKS**

In the Office Action, the Examiner rejected claims 1-25. Applicant, however, respectfully asserts that these claims are patentable and in condition for allowance. In view of the following, Applicant respectfully requests reconsideration and allowance of all pending claims (claim 1-25).

#### **Patentable Weight of Function Language**

As a preliminary matter, Applicant addresses the Examiner's assertion that "[f]unctional recitations using the word 'to' (e.g. 'to receive a completed query page' as recited in claim 1) have been considered by are given less patentable weight because the fail [*sic*] to add any structural limitations for this 'system' claim." Office Action mailed November 8, 2004, p. 7. Respectfully, Applicant disagrees with some of the Examiner's assertions regarding claim interpretation and the application of such interpretations to the instant claims.

Specifically, Applicant respectfully asserts that the language of the claims should not be compartmentalized in a manner that changes the meaning of the claim. For example, in claim 1, the term "to receive a completed query page" should not be viewed in an isolated manner. Rather, this recitation must be viewed as part of the tapestry of the entire claim, with the part-to-part relationship of the of the various recited elements of the claim in mind. Accordingly, Applicant respectfully asserts that it is not sufficient to summarily label various recitations of the claims as "intended use" simply for the use of the word "to."

Moreover, the Federal Circuit has held that "[a] patent applicant is free to recite features of an apparatus either structurally or functionally." *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997) (citing *In re Swinehart*, 169 U.S.P.Q. 226, 228 (C.C.P.A. 1971)). Indeed, "[t]here is nothing intrinsically wrong with defining something by what it does rather than what it is." *Id.* Furthermore, the Federal Circuit has

recognized that there is, at times, a “practical necessity for the use of functional language.” *In re Swinehart*, 169 U.S.P.Q. at 228. Thus, a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the art in the context in which it is used. *See* M.P.E.P. § 2173.05(g). Accordingly, an examiner must give patentable weight to a limitation that is recited functionally and, as such, to appropriate recitations that include the term “to.”

### **Rejections Under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 1-25 under 35 U.S.C. § 103(a) as obvious in view of various combinations and permutations of the Tavor et al. reference (U.S. Patent No. 6,070,149; hereinafter “Tavor”), the Doi et al. reference (U.S. Patent No. 5,224,177; hereinafter “Doi”), and the Henley reference (U.S. Patent Appl. No. 2002/0065758; hereinafter “Henley”). As discussed in turn below, Applicant respectfully traverses these rejections.

### **Legal Precedent**

First, Applicant respectfully reminds the Board that the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). To establish a *prima facie* case, the Examiner must not only show that the combination or modification includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *See Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). Thus, an examiner must fully articulate and identify the rejection, all evidence in support of the rejection, and all logical assertions related to the rejection. Moreover, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination or modification. *See ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929,

933 (Fed. Cir. 1984). Indeed, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). In other words, Applicant respectfully asserts that simply conclusory statements regarding the obviousness of a combination or modification will not do.

Indeed, the Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *See In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, when prior art references require a selected combination or modification to render obvious a subsequent invention, there must be some reason for the combination or modification other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination or modification. *See Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). With regard to examination, the Federal Circuit has warned that the examiner must not “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *See In re Dembiczak* 50 U.S.P.Q. 2d 52 (Fed. Cir.1999). (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir.1983)). Moreover, avoiding hindsight reconstruction is especially important regarding less technologically complex inventions, where the very ease which the invention can be understood may prompt one employ such hindsight. *See id.*

With the foregoing in mind, Applicant respectfully asserts that all pending claims are not obvious and, as such, patentable and in condition for allowance.

**First Rejection Under Section 103**

In the Office Action, the Examiner rejected claims 1-6 and 9-25 under 35 U.S.C. § 103(a) as obvious in view of Tavor and Doi. In rejecting independent claims 1 and 15, the Examiner stated that:

Tavor et al. disclose a computer system coupled to a network to select a product, comprising an application server (see Tavor et al., the abstract, and Fig. 1-ref. 18), and product selector/configuration file written in a markup language (see Tavor et al., 2:19-28 and Fig. 3), and stored in the computer system; Tavor et al. suggest questions to determine a product based on the customer's responses, a comparison program to receive a query page and compare customer's responses-by populating blanks of a web page (see Tavor et al., Fig 4. ref. 76, and Fig. 5 ref. 44); Tavor et al. also teach about a product configuration file written in markup language which contains information about the specific product (see Tavor et al., 2:19-28 and Fig. 3), and a server to provide a results page to the customer via the network (see Tavor et al., Fig. 1, and Fig. 4 ref. 76), the results page providing the customer with a recommend product.

Taylor [*sic*] fails to disclose the type of product being a radiological imaging workstation. Doi et al. teach a medical product: a CR system can be purchased (col. 8:61-62).

It would have been obvious at the time the invention was made to a person of ordinary skill in the art to use a CR system as the type of product being supplied in Taylor [*sic*] as disclosed in Doi since purchasing a radiological imaging workstation is a big investment, and there are many different models which a user may need a server to organize his priorities for recommendations when purchasing a proper product.

Office Action mailed November 8, 2004, pp. 2-3. Applicant respectfully traverses the rejection. As discussed further below, Applicant respectfully asserts that the cited references, taken alone or together, fail to disclose all of the features recited in the instant claims. Furthermore, Applicant respectfully asserts that that Examiner

has failed to present the requisite objective evidence necessary to establish a *prima facie* case of obviousness and that the Examiner has employed impermissible hindsight reconstruction to reach the instant claims.

1. **The cited references fail to disclose all of the features recited in the instant claims.**

As one example, the cited references fail to disclose a query page that “comprises a plurality of questions designed to enable the computer system to determine a recommended radiological imaging workstation based on the customer’s responses to the plurality of questions... wherein at least one of the plurality of questions establishes the imaging software to be recommended.” (Emphasis added.) Indeed, neither the Examiner nor the cited references themselves suggest a system that establishes a relationship between a hardware component and a software component for the hardware component, let alone the radiological imaging workstation and imaging software recited in the instant claim. Thus, as discussed above, the cited references cannot establish a *prima facie* case of obvious for at least claim 1 and the claims depending therefrom 2-14.

2. **The cited reference lack the requisite motivation for combination.**

Even if, *arguendo*, the cited references disclosed all of the features recited in the instant claims, Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* case of obviousness, because the Examiner has failed to present an objective line of reasoning or objective evidence to support the cited combination.

As the Examiner concedes, Tavor lacks any relation to imaging workstations. *See* Office Action mailed November 8, 2004, p. 3 (stating “Taylor [*sic*] fails to disclose the type of product being a radiological imaging workstation.”). However, as discussed above, to obviate this deficiency, the Examiner cites to a single line in Doi that states “[t]he CR system is expensive to purchase and maintain.” *See id.* (citing Doi, col. 8, l. 62). Based on the mere fact that a CR system can be purchased, the Examiner concludes

that it would have been obvious to combine the system of Tavor with Doi to reach the instant claims. *See id.* Respectfully, Applicant asserts that the Examiner's articulated reasoning is not sufficient to support a *prima facie* case of obviousness. Indeed, Applicant respectfully asserts that it is established precedent that the mere fact that a reference combination can be made is not sufficient to support a *prima facie* case of obviousness. *See In re Mills*, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990).

Moreover, the Examiner must look at the claimed invention as a whole, without distillation of the invention down to its gist. *See W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). That is, in determining the differences between the prior art and the claims, the question under Section 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *See Stratoflex, Inc. v. Aeroquip Corp.*, 218 U.S.P.Q. 871 (Fed. Cir. 1983). Thus, the Examiner must not look at each element of a claim individually, but rather the claims should be viewed as a complete fabric comprising the recited elements.

With respect to the present claims, the Examiner has not shown why one of ordinary skill in the art would find it obvious to modify the system of Tavor to reach the claimed system, in which elements are designed to determine a "recommended radiological imaging workstation," in view of the mere fact that a computed radiography (CR) system can be purchased.

Indeed, the Examiner's reasoning is wholly retrospective and based on the present application. As discussed above, "it is impermissible, however, to simply engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps." *In re Gorman*, 18 U.S.P.Q. 2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Simply put, what may seem logical to combine in retrospect and after viewing an applicant's invention is not obvious

unless the cited references, without benefit of this hindsight, teach what is claimed. *See In re Zurko*, 42 U.S.P.Q.2d 1476, 1479 (stating “[w]hile in retrospect, looking at applicants’ invention, it might seem logical to perform a repeat-back in the UNIX system over a trusted line, neither UNIX nor FILER2 teaches communications with the user of a trusted pathway,” as is recited in the claim in question).

**3. All pending claims are patentable and in condition for allowance.**

In view of the foregoing, Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully assert that independent claims 1 and its respective dependent claims 2-14 and independent claim 15 and its respective dependent claims 16-25 are patentable and in condition for allowance. Respectfully, Applicants request reconsideration and allowance of claims 1-25.

**Additional Rejection Under Section 103**

In the Office Action, the Examiner rejected dependent claims 6-8, 14, and 19-24 under 35 U.S.C. § 103(a) as obvious in view of Doi, Tavor, and Henley. Applicant, however, respectfully asserts that the addition of Henley fails to obviate the deficiencies of the Tavor-Doi reference combination discussed above. Accordingly, Applicant respectfully assert that dependent claims 6-8, 14, and 19-24 are patentable at least by virtue of their respective dependencies on allowable base claim 1 or 15. With the foregoing in mind, Applicants respectfully request reconsideration and allowance of dependent claims 6-8, 14, and 19-24.

**Conclusion**

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of all pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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